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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/443,204 | 11/18/1999 | JOHN EDWARD FETKOVICH | EN998146 | 6903 |
| 7590 08/26/2004 | | | EXAMINER | |
| KEVIN P RADIGAN ESQ HESLIN & ROTHENBERG PC 5 COLUMBIA CIRCLE ALBANY, NY 122035160 | | | SANTOS, PATRICK J D | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2171 | |

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/443,204

Applicant(s)

FETKOVICH ET AL. 26

Examiner

Patrick J Santos

Art Unit

2171

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 28 June 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet


SAFET METJAHIC
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TECHNOLOGY CENTER 2100

09/443,204

Continuation of 10. Other: Examiner's response to Applicant's Amendment After Final filed June 18, 2004, is as follows:

Argument 1: Applicant Asserts "Impermissible Hindsight" (Amendment After Final, p. 2)

- Examiner replies: Any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Examiner's Final Office Action on March 23, 2004 provides specific citations from the prior art as motivation to combine the Jones, Nardone, and Leppek patents (Final Office Action, p.34, see Ins. 3-21), thus does not posit motivation to combine from knowledge gleaned from the applicant's disclosure. Since motivation to combine is demonstrated to be obtained from sources other than applicant, Claim rejections from Examiner's Final Office Action do not use "Impermissible Hindsight."

Argument 2: Applicant Asserts Prior Art Individually Differs From Applicant's Claims (Amendment After Final, pp. 3-7)

- Examiner replies: One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Examiner refers to Examiner's Final Office Action filed March 23, 2004, paragraph 12, pp. 32-35 for a description of the combination. Examiner notes that the combination of the Jones, Nardone, and Leppek references in fact do cover the limitations and reiterates arguments 1-4 from Examiner's Final Office Action, paragraph 13, pp. 35-36.

Argument 3: Applicant Asserts Prior Art Does Not Disclose a Predefined Policy (Amendment After Final, p. 3, see, In. 20)

- Examiner replies: Nardone discloses a policy, as admitted, in Applicant's After Final, p. 5, In. 8.

- Examiner further replies: It is noted that the feature upon which applicant relies (i.e., a policy) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Examiner points out that the language of the claims as per the amendment filed December 29, 2003 states a "predefined condition" rather than a "predefined policy." A policy is a high level overall plan that consists of at least one condition, and certainly may consist of a plurality of conditions. Since a policy is broader than a condition, and because the claim language only refers to a condition rather than a policy, Examiner replies that requiring the prior art to disclose a policy is to rely on a feature not recited in the claims. Thus even if the prior art were not to disclose a policy (which Examiner does not admit (*supra*)) this would not be a reason to reverse the claim rejections. Conversely, since a policy subsumes a condition, prior art which reads on a policy, also reads upon a condition.

Argument 4: Applicant Asserts That One of Ordinary Skill In The Art Would Not Be Motivated To Combine (Amendment After Final, p. 7, Ins. 11-28)

- Examiner replies: Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, a person having ordinary skill in the art is a cryptographer aware of the variety of ways to reduce a cryptographic footprint, including the prior art as disclosed by Jones, Nardone, and Leppek, which includes varying parameters (again refer to Final Office Action filed March 23, 2004, paragraph 12, pp. 32-35). This ordinarily skilled cryptographer, faced with the problem reducing a cryptographic footprint to the peculiarities of a data stream such as MPEG compressed video or audio (disclosed as prior art in Applicant's Specification, p. 2, Ins. 5-20), naturally will vary parameters specific to that data stream.

- Examiner further replies: Applicant further denies prior art disclosing motivation to combine by denying that signaling exists in the Jones, Nardone, and Leppek combination. Examiner refers to arguments provided in Final Office Action, paragraph 12, p. 35, Ins. 1-10.

Argument 5: Applicant Asserts That Aucsmith Reference Combined With Jones, Nardone, and Leppek Do Not Address Arguments 1-4 Above (Amendment After Final, p. 8, Ins. 1-13)

- Examiner refers to above replies to Arguments 1-4.

Argument 6: Applicant Asserts That Warren Reference Combined With Jones, Nardone, and Leppek Do Not Address Arguments 1-4 Above (Amendment After Final, p. 8, Ins. 14-23)

- Examiner refers to above replies to Arguments 1-4.

Argument 7: Applicant Asserts That Chariglione Reference Combined With Jones, Nardone, Leppek, and Aucsmith or Warren Do Not Address Arguments 1-4 Above (Amendment After Final, p. 8, Ins. 14-23)

- Examiner refers to above replies to Arguments 1-4.